

PTO Form 2194 (Rev 5/2006)

OMB No. 0651-0054 (Exp. 11/30/2008)

## Petition To Revive Abandoned Application - Failure To Respond Timely To Office Action

The table below presents the data as entered.

| Input Field   | Entered   |
|---|---|
| <b>SERIAL NUMBER</b>  | 76352528  |
| <b>LAW OFFICE ASSIGNED</b>  | LAW OFFICE 108  |
| <b>DATE OF NOTICE OF ABANDONMENT</b>  | 11/28/2005  |
| <b>PETITION</b>   |   |
| PETITION STATEMENT  | Applicant has firsthand knowledge that the failure to respond to the Office Action by the specified deadline was unintentional, and requests the USPTO to revive the abandoned application. |
| <b>RESPONSE TO OFFICE ACTION</b>  |   |
| <b>MARK SECTION (no change)</b>   |   |
| <b>ARGUMENT(S)</b>  |   |
| <b><u>IN THE UNITED STATES PATENT AND TRADEMARK OFFICE</u></b>  |   |
| Applicant:  | The Echo Design Group, Inc.   |
| Mark:   | ECHO  |
| Serial No.:   | 76/352,528  |
| Int. Classes:   | 18, 25  |
| Filing Date:  | December 22, 2001   |
| Our Ref.:   | ECHOD-013   |
| <b><u>AMENDMENT AND REQUEST FOR RECONSIDERATION</u></b>   |   |
| On behalf of The Echo Design Group, Inc. ("Applicant"), please enter the following amendment and consider the following response to the Office Action dated April 29, 2005. |   |
| <b><u>AMENDMENT</u></b>   |   |

**I. Amendment**

Please delete the identification of goods in International Class 25 in its entirety and replace it with the following recitation thereof:

Rainwear, excluding rain boots and rain shoes in Class 25.

**II. Request to Divide**

In the event that the Examining Attorney does not allow Applicant's application to proceed to publication as originally filed based on the arguments presented below, Applicant requests a division of the above referenced application under 37 C.F.R. § 2.87.

Specifically, Applicant requests that the Examining Attorney divide out those goods recited in Class 25 to which the Examining Attorney suggests that the likelihood of confusion refusal applies, namely,

RAINWEAR in International Class 25,  
and allow those goods in International Class 18, namely, UMBRELLAS, to proceed to publication.  
(The fee to divide the instant application has been included in the payment made upon the submission of this filing.)

**REQUEST FOR RECONSIDERATION**

The Examining Attorney has made final her refusal to register Applicant's mark under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), finding that the mark, when used on or in connection with the identified goods, so resembles the mark in Registration Nos. 2,331,090, 1,935,123, and 1,753,970 as to be likely to cause confusion, or to cause mistake, or to deceive. For the reasons discussed below Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register.

**Likelihood of Confusion**

The Examining Attorney has cited the marks ECCO (stylized), owned by Ecco Sko A/S (the "Cited Registrant"), as shown in U.S. Registration Nos. 2,331,090 for "footwear," 1,935,123 for "footwear," and 1,753,970 for "casual walking shoes (the "Cited Marks") as a bar to registration of Applicant's mark on the grounds that Applicant's mark is likely to cause confusion, to cause mistake, or to deceive. The Examining Attorney has stated that this objection pertains only to Applicant's

Class 25 goods, "rainwear."

In making a determination concerning likelihood of confusion, all of the relevant factors enumerated by the Court in *In re E.I. DuPont de Nemours and Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973) (hereinafter, "DuPont"), must be analyzed and all relevant facts must be considered on a case-by-case basis. Important factors to be considered in an analysis of likelihood of confusion include:

(A) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use, as well as channels of trade; and

(B) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

*DuPont*, 177 U.S.P.Q. at 567. We analyze each factor below:

(A) The goods for which the Applicant seeks registration are dissimilar to the goods listed in the cited registration. Applicant seeks to register its mark in connection with rainwear. By contrast, Registrant's goods consist of footwear and casual walking shoes. There are specific differences between rainwear and footwear. Rainwear is by definition functional in that it is clothing purchased by a consumer with the specific intent to be worn in rainy weather. Rainwear and footwear are not complementary items as are hats and gloves. Footwear is purchased with care typically with the assistance of a salesman; whereas rainwear, as with other types of clothing, is purchased without the aid of sales person. Further, rainwear and footwear, in most instances, would not be placed in proximate areas in the retail setting and typically are found in a designated section of a catalog or website. Upon contemplating such factors the Board has found no likelihood of confusion between the same or similar marks used for shoes and apparel. See *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984)(PLAYERS for men's underwear not confusingly similar to PLAYERS for shoes). Additionally, as is clear from Applicant's amended application, it does not seek to register its mark in connection with footwear in any way.

As evidence of the relatedness of rainwear and footwear and the similarity of the channels of

trade for such goods, the Examining Attorney has provided references to web sites wherein rainwear and footwear are marketed together. It does not follow, however, that because such web sites sell both rainwear and footwear, those goods are necessarily related. A retail establishment may make use of a given mark on bicycles and t-shirts, but bicycles and t-shirts are not therefore necessarily related goods. The third party web sites cited by the Examining Attorney only prove that one source offers two unrelated goods. Further, while there have been some cases where the Trademark Trial and Appeal Board and the Courts have held different types of apparel to be related for purposes of Section 2(d), there is no *per se* rule governing likelihood of confusion in cases involving rainwear and footwear. *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (courts have "backed away from the application of such 'per se' rules" in instances where same or similar marks are used on different items of wearing apparel).

(B) Applicant and the owner of the cited registration have coexisted with each other for nearly thirty years, or since the owner of the cited registration began using its mark. On information and belief, there has never been an instance of confusion relating to the two marks. Nearly thirty years of coexistence without evidence of confusion is strong evidence of the sophistication of the purchasers and lack of confusing similarity between the marks used in conjunction with their respective goods. Although evidence of actual confusion is not necessary to prove likelihood of confusion, *Ford Motor Co. v. Summit Motor Products, Inc.*, 930 F.2d 277, 292 (3d Cir. 1991), such concurrent use for a substantial period of time with no confusion may create a "presumption that there is little likelihood of confusion," and weighs heavily against a finding of likely confusion. *Barre-National, Inc. v. Barr Laboratories, Inc.*, 773 F. Supp. 735, 744 (D.N.J. 1991); see also, *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482 (1st Cir. 1981); *Aktiebolaget Electrolux v. Armatron Int'l, Inc.*, 999 F.2d 1 (1st Cir. 1993) ("absence of actual confusion, or a negligible amount of it, between two products after a long period of coexistence on the market is highly probative in showing that likelihood of confusion exists"); *Gruner & Jahr USA Public. v. Meredith Corp.*, 793 F. Supp. 1222, 1232-33 (S.D.N.Y. 1992) (where both parties products have been on the market for six months, "we find that the absence of evidence of actual confusion weighs heavily against a finding of likelihood of confusion"), *aff'd*, 991 F.2d 1072 (2d Cir. 1993); *Mars, Inc. v. H.P. Mayer Corp.*, 1988 WL

86314, \*2 (D.N.J. Aug. 17, 1988) (finding that where "defendants have been distributing [the product in question] for approximately six months, without any evidence of actual confusion occurring, that there is little to no likelihood" of confusion).

\* \* \*

In sum, the differences between the respective goods, the channels of trade through which the goods are sold, and the nearly three decades of coexistence without actual confusion preclude a finding of likelihood of confusion between Applicant's mark and the cited registrations.

### CONCLUSION

By this Amendment and Response, Applicant believes that the mark ECHO is entitled to registration on the Principal Register. Therefore, Applicant respectfully requests that the Examining Attorney approve the mark for publication at an early date. Applicant has submitted a Notice of Appeal contemporaneously with this Amendment and Response.

Applicant requests that the Examining Attorney telephone Vincent A. Sireci at (212) 696-8794 if she has any further questions regarding the application.

Date: January 26, 2006

Respectfully submitted,  
Vincent A. Sireci  
General Counsel

The Echo Design Group, Inc.  
10 East 40<sup>th</sup> Street  
New York, New York 10016-0296  
Tel: 212-696-8794  
Fax: 212-686-5017  
E-mail: vsireci@echodesign.com  
Attorney for Applicant  
The Echo Design Group, Inc.

#### **GOODS AND/OR SERVICES SECTION (018)(no change)**

#### **GOODS AND/OR SERVICES SECTION (025)(current)**

|                     |              |
|---------------------|--------------|
| INTERNATIONAL CLASS | 025          |
| DESCRIPTION         | RAINWEAR     |
| FILING BASIS        | Section 1(b) |

#### **GOODS AND/OR SERVICES SECTION (025)(proposed)**

|                     |     |
|---------------------|-----|
| INTERNATIONAL CLASS | 025 |
|---------------------|-----|

|                                   |   |
|-----------------------------------|---|
| DESCRIPTION                       | RAINWEAR, EXCLUDING RAIN BOOTS AND RAIN SHOES   |
| FILING BASIS                      | Section 1(b)  |
| <b>PAYMENT SECTION</b>            |   |
| NUMBER OF CLASSES                 | 1   |
| FEE PER CLASS                     | 325   |
| TOTAL FEES DUE                    | 425   |
| <b>SIGNATURE SECTION</b>          |   |
| DECLARATION SIGNATURE             | /Vincent A. Sireci/   |
| SIGNATORY NAME                    | Vincent A. Sireci   |
| SIGNATORY POSITION                | General Counsel   |
| SIGNATURE DATE                    | 01/27/2006  |
| RESPONSE SIGNATURE                | /Vincent A. Sireci/   |
| SIGNATORY NAME                    | Vincent A. Sireci   |
| SIGNATORY POSITION                | General Counsel   |
| SIGNATURE DATE                    | 01/27/2006  |
| <b>FILING INFORMATION SECTION</b> |   |
| SUBMIT DATE                       | Fri Jan 27 10:15:57 EST 2006  |
| TEAS STAMP                        | USPTO/POA-65.200.176.197-<br>20060127101557701919-7635<br>2528-320b5d5cb87206d93525<br>e8b7485cbd74e48-CC-1093-2<br>0060127094846977054 |

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OMB No. 0651-0054 (Exp. 11/30/2008)

### Petition To Revive Abandoned Application - Failure To Respond Timely To Office Action

**To the Commissioner for Trademarks:**

Application serial no. **76352528** is amended as follows:

**PETITION**

**Petition Statement**

Applicant has firsthand knowledge that the failure to respond to the Office Action by the specified deadline was unintentional, and requests the USPTO to revive the abandoned application.

**RESPONSE TO OFFICE ACTION****Argument(s)**

In response to the substantive refusal(s), please note the following:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: The Echo Design Group, Inc.

Mark: ECHO

Serial No.: 76/352,528

Int. Classes: 18, 25

Filing Date: December 22, 2001

Our Ref.: ECHOD-013

Examining Attorney  
Andrea D. Saunders  
Law Office 108

**AMENDMENT AND REQUEST FOR RECONSIDERATION**

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**AMENDMENT****I. Amendment**

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\* \* \*

In sum, the differences between the respective goods, the channels of trade through which the goods are sold, and the nearly three decades of coexistence without actual confusion preclude a finding of likelihood of confusion between Applicant's mark and the cited registrations.

o

#### CONCLUSION

By this Amendment and Response. Applicant believes that the mark ECHO is entitled to registration on the Principal Register. Therefore, Applicant respectfully requests that the Examining Attorney approve the mark for publication at an early date. Applicant has submitted a Notice of Appeal contemporaneously with this Amendment and Response.

Applicant requests that the Examining Attorney telephone Vincent A. Sireci at (212) 696-8794

if she has any further questions regarding the application.

Date: January 26, 2006

Respectfully submitted,  
Vincent A. Sireci  
General Counsel

The Echo Design Group, Inc.  
10 East 40<sup>th</sup> Street  
New York, New York 10016-0296  
Tel: 212-696-8794  
Fax: 212-686-5017  
E-mail: vsireci@echodesign.com  
Attorney for Applicant  
The Echo Design Group, Inc.

**Classification and Listing of Goods/Services**

**Applicant hereby amends the following class of goods/services in the application as follows:**

Current: Class 025 for RAINWEAR

Original Filing Basis: 1(b).

Proposed: Class 025 for RAINWEAR, EXCLUDING RAIN BOOTS AND RAIN SHOES

**Fees**

Fee(s) in the amount of \$425 is being submitted.

**Declaration Signature**

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Vincent A. Sireci/ Date: 01/27/2006

Signatory's Name: Vincent A. Sireci

Signatory's Position: General Counsel

**Petition/Response Signature**

Signature: /Vincent A. Sireci/ Date: 01/27/2006

Signatory's Name: Vincent A. Sireci

Signatory's Position: General Counsel

Serial Number: 76352528

Internet Transmission Date: Fri Jan 27 10:15:57 EST 2006

TEAS Stamp: USPTO/POA-65.200.176.197-200601271015577

01919-76352528-320b5d5cb87206d93525e8b74

85cbd74e48-CC-1093-20060127094846977054

RAM SALE NUMBER: 1093  
RAM ACCOUNTING DATE: 20060127

INTERNET TRANSMISSION DATE:  
2006/01/27

SERIAL NUMBER:  
76/352528

| Description | Fee<br>Code | Transaction | Total Fees<br>Paid |
|-------------|-------------|-------------|--------------------|
| POA         | 7005        | 2006/01/27  | 100                |
| APP         | 7001        | 2006/01/27  | 325                |